

REMARKS

Reconsideration and further examination is respectfully requested. Claim 1 is pending.

Claim Rejection – Section 102:

The Examiner has rejected claim 1 under 35 U.S.C. § 102(f) as being unpatentable over Miller (U.S. Patent No. 6,676,617). Specifically, the Examiner asserts that the Applicant for the pending application did not invent the subject matter set forth in claim 1. As claim 1 is patentably distinguishable from Miller, this rejection is respectfully traversed.

The Examiner asserts that “[t]he patent issued to **John J. Miller**” (U.S. Patent No. 6,676,617) discloses an iliac crest belt assembly adapted for interlocking attachment to a body brace having a back element shaped to fit about a person’s lower back region...” Office Action, page 2. The Examiner then sets forth the elements in Claim 1 and attempts to match them with the feature numbers disclosed in the ‘617 patent. However, for the detailed reasons set forth below, the Applicant traverses the instant rejection.

The pending application and the ‘617 patent are commonly owned via assignment to Boston Brace International, Inc. On November 1, 2000, Applicant’s previous counsel filed two applications, U.S. Patent Application No. 09/703,860 (“the ‘860 application”), which issued as the ‘617 patent by John J. Miller, and U.S. Patent Application No. 09/705,861 (“the ‘861 application” and the parent application of the currently pending application) by James Russell Miller. The ‘861 application contained identical disclosure to that of the ‘860 application save for a few minor clerical changes in the specification. The only significant difference between the two applications was the subject matter of the claims set forth in each application. There were 62

claims in the '860 application, all of which were directed to the body brace disclosed in the specification. All 32 claims in the '861 application were directed to the iliac crest belt disclosed in the specification. The body brace and the iliac crest belt are separate inventions.

35 U.S.C. § 102(f) states that "[a] person shall be entitled to a patent unless he did not himself invent the subject matter sought to be patented." United States Code Title 35, Rev. 3, August 2005. MPEP § 706.02 (g) provides and clarifies, in pertinent part, that "35 U.S.C. 102 (f) bars the issuance of a patent where an applicant did not invent the subject matter being claimed and sought to be patented." Manual of Patent Examining Procedure, September 2005 (emphasis added). The critical factor on which inventorship is based is the subject matter of the claims, as recited in the MPEP, and not the totality of the disclosure.

When the '860 and '861 applications were filed on November 1, 2000, prior counsel for the respective Applicants could have proceeded with a single application naming both inventors, John J. Miller and James Russell Miller, and containing 94 claims, 62 of which were directed to the body brace structure and 32 claims directed to the iliac crest belt. In the normal course of prosecution, an Examiner would have issued a restriction requirement stating that the body brace and the iliac crest belt were two distinct inventions and requiring the Applicants to make an election of one set of claims to prosecute before the Patent Office. See 35 U.S.C. § 121 and 37 C.F.R. §§ 1.141-1.142. In that event, the Applicants would have chosen to proceed with the set of claims directed to the body brace invented by John J. Miller, or the set of claims directed to the iliac crest belt invented by James Russell Miller, and to contemporaneously or subsequently file a divisional application for the non-elected set of claims. The divisional application would have received the priority date of November 1, 2000 as well.

Pursuant to 35 U.S.C. 256 and 37 C.F.R. 1.48(b), the applicants would have had to correct inventorship for the two applications before or after the issuance of the respective patents. A correction of inventorship in the patent application for the body brace would have required the deletion of James Russell Miller as a co-inventor, leaving John J. Miller as the sole inventor. Likewise, a correction of inventorship in the patent application for the iliac crest belt would have required the deletion of John J. Miller as a co-inventor, leaving James Russell Miller as the sole inventor. Hence, with the corrections of inventorship, the applications would have ended up in the same disposition that they are in presently.

Accordingly, counsel's choice to file two separate applications on November 1, 2000 containing separate sets of claims and to list the applicants separately according to the subject matter set forth in the corresponding claims was an appropriate method of filing. 35 U.S.C. 102(f) and MPEP § 706.02 (g) support counsel's filing method. John J. Miller is not the inventor of the subject matter set forth in the '861 application. John J. Miller is not the inventor of the iliac crest belt.

The '861 application received a Final Office Action on August 26, 2003 containing a rejection of all of the claims pending in the application. Counsel filed a Notice of Appeal and a Petition for One Month's Extension of Time on December 18, 2003. The Request for Extension was granted on the same day. The filing of the Notice of Appeal resulted in a due date of February 18, 2004 for the filing of an Appeal Brief in the '861 application. On April 14, 2004, Counsel filed a Petition for Two Month Extension to File to File the Appeal Brief. This Request for Extension was granted the same day, thereby extending the time to file the Appeal Brief to April 18, 2004.

On April 14, 2004, Counsel filed the currently pending application, U.S. Patent Application No. 10/824,765 (“the ‘765 application”), which is a continuation of the ‘861 application. A Notice of Abandonment was issued on March 1, 2005 for failure to reply to the Final Office Action of August 26, 2003, namely due to Counsel’s election not to file the Appeal Brief before April 18, 2004. Section 1205.01 of the MPEP provides that in the event that the Applicant fails to file an Appeal Brief, and “[i]f there are no allowed claims, the application is abandoned as of the date the brief was due.” Accordingly, the ‘861 application was abandoned as of April 18, 2004, which was four days after the ‘765 continuation application was filed. The disclosure in the ‘765 continuation application is identical to that of the parent ‘861 application. One claim, that which is currently pending, was filed in the ‘765 application. As such, the claim is entitled to the benefit of the filing date of the patent application, November 1, 2000.

Accordingly, the pending claim invented by James Russell Miller relates back to November 1, 2000, the same filing date of the ‘860 application to John J. Miller, which subsequently issued as the ‘617 patent. Applicant asserts that the Miller patent is not and cannot be prior art against the pending claim. The fact that the subject matter was also disclosed in the specification is not relevant to the issue of inventorship, which focuses on the subject matter of the claims set forth in each application. In the course of patent prosecution, inventors may be added or deleted from applications in accordance with the addition or cancellation of the subject matter that they invented, and as presented in the claims. As discussed in the remarks herein, Applicant also asserts that John J. Miller is not the inventor of claim 1, and that James Russell Miller is the true inventor of the subject matter claimed therein, the iliac crest belt. The rejection of claim 1 is respectfully traversed.

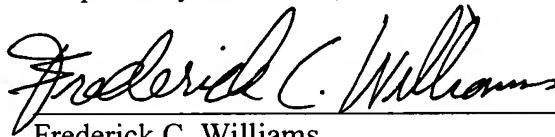
Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Frederick C. Williams, Applicants' Attorney at (202) 842-0431 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

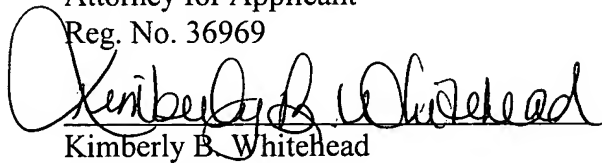
Nov. 17, 2005  
Date

11/17/2005  
Date

Respectfully Submitted,



Frederick C. Williams  
Attorney for Applicant  
Reg. No. 36969



Kimberly B. Whitehead  
Attorney for Applicant  
Reg. No. 55330

Burns & Levinson LLP  
1030 Fifteenth Street, N.W.  
Suite 300  
Washington, DC 20005-1501  
Tel. (202) 842-0431  
Fax: (202) 467-4045